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09/753,869	01/03/2001	Richard Griffey	IBIS-0339	1982

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EXAMINER

BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 05/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/753,869

Applicant(s)

GRIFFEY ET AL.

Examiner

Michael Borin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Mar 25, 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 12 and 13 is/are pending in the application.

4a) Of the above, claim(s) 13 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 12 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

DETAILED ACTION

Status of Claims

1. Amendment filed 11/25/2002 and response to restriction requirement filed 05/23/03 are acknowledged. Applicant elected claim 12 with traverse. Applicant argues that the claims can be searched without additional burden. As was stated in the restriction requirement, the methods of claims 12 and 13 contain specific method steps which are not shared by each other: Group II.2 requires steps of representing each fragment as a "transformation", and including reagent information in "transformation", not required for Group II.1; further, synthesis rounds in Group II.1 are combinations of fragments, whereas synthesis rounds in Group II. 2 are combinations of links between fragments and reagents. All these differences necessitate different searches of patent and scientific literature databases. For these reasons the restriction requirement is deemed to be proper and is therefore made FINAL.

Claims 1-11, 14-26 are canceled. Claims 12,13 are pending. Claim 13 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected group. Claim 12 is under examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as obvious over STN Express User Guide (version 4.0, 1996).

Claim 12 is drawn to method of identifying, *in silico*, a compound, comprising, for claim 12 steps of:

- a) selecting a compound from virtual library, and dissecting a compound into fragments,
- b) assigning identifying characteristic to each fragment;
- c) adding fragments in sequential synthesis rounds;
- d) tracking the addition of the fragments and assigned information in a database;
- e) identifying a compound by its fragments and transformations.

STN's Guide teaches methods of presenting chemical compound formulas *in silico*. The Guide teaches that a compound can be presented, first, as a set of fragments, then fragments can be placed together, and added together at variable

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points of attachments according to valencies of the fragments. See pages 110-115.

Further, the reference teaches that the fragments can be labeled as a reagent or a reactant, as well as link therebetween can be identified (see pages 164-179). The results can be stored.

The reference does not specifically teaches to select a compound from a virtual library of compounds.

It would have been *prima facie* obvious to one skilled in art at the time the invention was made to be motivated to use the STN's method to present in fragments and their transformation any compound regardless of their origin, including compounds selected from a virtual library.

Response to arguments

Applicant argues that there is no limitation of selecting compounds from library. This is no reflected in the rejection which is changed to rejection under 35 U.S.C. 103(a) to reflect this difference.

Further, applicant argues that there assigning identifying and transformation characteristics is not addressed in the rejection. Examiner disagrees. The reference teaches that the fragments can be labeled as a reagent or a reactant, as well as link therebetween can be identified (see pages 164-179). This is equivalent to assigning identifying and transformation characteristics.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claim 12 is rejected under the judicially created doctrine of double patenting over claims 8,9 of U. S. Patent No. 6253168 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter because "generating database comprising information about member compounds in a virtual library of compounds" (preamble in referenced claims) is the same as identifying compounds of *in silico* library by its fragments and transformations stored in database (as instantly claimed). The method steps are the same.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

May 16, 2003

mlb

